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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,912	01/17/2002	Zhi-Yuan Shen	CL1259USCNT1	3357

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EXAMINER

LEE, BENNY T

ART UNIT PAPER NUMBER

2817

DATE MAILED: 06/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



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DATE MAILED:

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

- ☐ This application has been examined ☒ Responsive to communication filed on 23 Dec 2002 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 2 month(s), 0 day(s) from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|--|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449 | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474 | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 1, 3-23 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☒ Claims 1, 12-23; 3-17 are allowed.
4. ☐ Claims _____ are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with Informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☒ The corrected or substitute drawings have been received on 23 Dec 2002. These drawings are ☒ acceptable; ☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☒ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

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The disclosure is objected to because of the following informalities: Page 1, note that updated status information for parent application SN 592466 should be provided. Page 6, lines 36, 37, note that ~~--prior art--~~ should precede "square" and "circular", respectively. Page 12, line 30, note that ^{1 a} ~~"1"~~ should be rewritten as ~~--1a--~~. Page 18; line 30, note that ~~--numeral--~~ should precede "75" for consistency of description. Page 19, line 17, note that ~~--(see Fig. 8a)--~~ should follow "83a" for clarity. Page 19, line 32 to page 20, line 20 should reference ~~--Fig. 8a--~~ for clarity of description. Page 21, line 8, note that ~~--(see Fig. 9a)--~~ should follow "93a" for clarity. Page 21, lines 12-20 should reference ~~--Fig. 9--~~ for clarity of description. Page 22, lines 18-29 should reference ~~--Fig. 10a--~~ for clarity of description. Pages 24, 25, note that further elaboration as the relevant aspects of the curves depicted in Figs. 13a-13d, 14, 15 need to be provided.

Appropriate correction is required.

The drawings are objected to because of the following: In fig. 3a, tuning pad ~~--36--~~ needs to be labeled; In fig. 8a, note that reference labels (89, 89a) should correctly be ~~--(88a, 88b)--~~ as per page 20, line 18 of the specification. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the case as recited in claims 1, 3 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Fig 11a

119 Fig. 11a

line 1c

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A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claims 3-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 3, note that it is unclear how the "input/output coupling circuit" is operatively coupled/associated with the earlier recited "input/output line" for each mini-filter. Clarification is needed.

In claim 11, note that "in the parallel lines form ..." is vague in meaning.

The following claims have been found objectionable for reasons set forth below:

In claim 1, at (b), and claim 3, at (e), note that "form" should be rewritten as --provide-- and --resonator-- should follow "within the spiral"; at (d) and (e) of claim 1, and at (g) and (h) of claim 3, note that --thereof-- should follow each occurrence of "end".

In claim 1, at (g) and (j); claim 3, at (j); claim 12, at (m): note that --conductive-- should precede "film" for a proper characterization.

In claim 1, at (j), note that "a case" should be rephrased as --said case-- for consistency with an earlier recitation.

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In claim 3, at (b) and (c), note that "wherein one" should be rephrased as --wherein a respective-- and "a corresponding (input/output) of one" should be rephrased as --an (input/output) of a corresponding-- for a better characterization.

In claims 5, 16 note that --respective-- should precede "conductive" for a proper characterization.

In claim 10, note that --said-- should follow "all" for a proper characterization.

In claim 11, at (b), should "the said mini-filter" be properly phrased as --each said mini-filter?

In claim 13, line 2, note that --respective-- should precede "superstrate"; line 2, 5, note that --corresponding-- should precede "substrate" and "superstrate", respectively.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

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Claim 1 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 10 of prior U.S. Patent No. 6370404. This is a double patenting rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5, 14 of U.S. Patent No. 6108569 in view of Mansour.

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Claim 1 of the application substantially corresponds to claim 5 of the '569 patent, except for the recitation of a case for the mini-filter. Claim 2 of the application corresponds to claim 14 of the '569 patent.

Mansour (e.g. fig. 1) provides as an exemplary teaching thereof that placing superconductive filters/resonators (2) in a housing (32) is considered conventional in the art.

Accordingly, in view of the teaching of Mansour, the placing the mini-filter as recited in claims 5, 14 of the '569 patent within a case would have been considered a conventional modification for packaging such mini-filter, thereby suggesting the obviousness of such a modification. Claims 3-5, 7, 8, 10, 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15-20 of U.S. Patent No. 6108569 in view of Mansour. Claim 3 of the application substantially corresponds to claim 15 of the '569 patent except for the recitation of a case for the mini-multiplexer. Claims 4, 10 of the application substantially corresponds to claim 20 of the '569 patent. Claim 5 of the application corresponds to claim 19 of the '569 patent.

Claim 7 of the application corresponds to claim 18 of the '569 patent. Claim 8 of the application corresponds to claim 16 of the '569 patent. Claim 12 of the application corresponds to claim 17 of the '569 patent.

Accordingly, placing the mini-multiplexer recited in claims 15-20 of the '569 patent in a case (e.g. 32) as exemplarily taught by Mansour, would have been considered a conventional

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modification for packaging such mini-multiplexer, thereby suggesting the obviousness of such a modification.

The paper to Ong et al, cited by applicant, has not been considered at this time since the citation lacks a publication date. Upon a submission of a publication date for this citation by applicant, the Ong et al paper will be duly considered by the examiner.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nakamura pertains to multiplexing filter. Murphy pertains to a coil with adjacent line spacing being less than the line width. Roche et al discloses a superstrate which exposes input/output terminals.

Any inquiry concerning this communication should be directed to Benny Lee at telephone number (703) 308-4902.



BENNY T. LEE
PRIMARY EXAMINER
ART UNIT 2817
B. Lee/mm

06/12/02